Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte FREDERICK L. MERRITT, Jr.

Appeal No. 2005-0081
Application No. 09/625,660

ON BRIEF

Before JERRY SMITH, CRAWFORD, and DIXON, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 14, which are all of the claims pending in this application.

The appellant's invention relates to a combination on-line sweepstakes and sales system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The References

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dedrick	5,724,521	Mar. 3, 1998
Eggleston et al. (Eggleston)	6,061,660	May 9, 2000 (filed Mar. 18, 1998)

The Rejections

Claims 1 to 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eggleston in view of Dedrick.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed May 18, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed March 29, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection is made under 35 U.S.C. § 103. Initially we note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references, it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The examiner is of the opinion that Eggleston discloses the invention as recited in claim 1 except that Eggleston does not disclose: (1) that the player is directed to the advertising based on a comparison of the information stored about the player and stored target advertising profiles, (2) that a particular advertiser pays a predetermined amount for the directing of the sweepstakes player to the specific advertisement, and (3) that the prizes can be delivered once the cost of that prize or a surplus of that cost

has been satisfied. In regard to the comparison language of claim 1, the examiner states:

> However, Eggleston further discloses that the incentives information can include advertising (col 34, lines 41- 47). Eggleston further discloses directing the user to advertising (col 1, lines 36 - 41) and targeting the user to particular programs (col 31, lines 35 - 40; col 42, lines 35 - 40).
>
> Therefore, it would be obvious to Eggleston that the advertising the user is directed to can be targeted. One would have been motivated to do this so that the user goes to a site they are more likely interested in [answer at pages 4 to 5].

In regard to the limitation in claim 1 that the advertiser pays a predetermined amount for the directing of said sweepstakes player to the specific advertisement, the examiner relies on Dedrick for disclosing playing games and charging for directing a user to advertising and concludes:

> Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's charging for directing advertising to Eggleston's directing user's to advertisements. One would have been motivated to do this because it is targeted users are of interest to advertisers [answer at page 5].

The examiner points to the disclosure in Eggleston relating to distributing a particular prize once a predetermined threshold is met (col. 30, line 65 to col. 31, line 5), that prizes cost money (col. 15, lines 6 to15), and the disclosure of tracking sponsor expenses (col. 39, lines 40 to 51) and concludes:

> Therefore, in light of Eggleston being able to charge for directing advertising as disclosed above, it would have been obvious to Eggleston to offer the prize once the cost of the prize has been satisfied. One would have been motivated to do this so that the sponsor can assure that their expenses are well maintained [answer at pages 5 to 6].

The appellant argues that were the teachings of Eggleston and Dedrick combined there would be no teaching of distributing the prize once a predetermined revenue has been generated.

We agree with the appellant that the combined teachings of the references would not have suggested the above noted feature and thus we will not sustain this rejection as it relates to claim 1.

The examiner admits that there is no disclosure in the references of distributing a prize once a predetermined revenue has been generated. However, the examiner reasons that since Eggleston discloses that a prize is distributed once a predetermined threshold is met and that prizes cost money, it would have been obvious to Eggleston to offer the prize once the cost of the prize has been satisfied.

We do not agree with the examiner that the above noted disclosures in the Eggleston reference would have suggested to a person of ordinary skill in the art at the time of the invention to modify the teachings of the Eggleston reference so that a prize is distributed once a predetermined revenue has been generated.

While the examiner is correct that Eggleston discloses that there is a predetermined threshold that must be met before the prize is distributed, this threshold relates to the player rather than the amount of revenue generated. For Example, Eggleston discloses that a player must earn a certain number of points to be eligible for a sweepstakes prize (col. 30, line 63 to col. 31, line 2; col. 35, lines 25 to 30). However, there is nothing in either Eggleston or Dedrick that would have suggested to a person of ordinary skill in the art that a sweepstakes is conducted once a predetermined revenue has been generated as is recited in independent claim 1 and as similarly recited in independent claims 10, 11, 12 and 14. Therefore, we will not sustain the rejection as it is directed to claims 1, 10, 11, 12 and 14. We will also not sustain the rejection as it is directed to claims 2 through 9 and 13 as these claims depend from one of the independent claims.

In view of the foregoing, the decision of the examiner is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 14 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

JERRY SMITH
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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